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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,623	07/22/2003	Marcel Huard	12296-23-US/AME0001-RI	5036

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WASHINGTON, DC 20005

EXAMINER
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SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,623

Applicant(s)

HUARD ET AL.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Reissue Applications***

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6139430 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

### ***Claim Interpretation***

2. It is noted that Applicant has copied claims from 5707285C1 to invoke interference therewith. No clear delineation of claim interpretation or how copied features/steps regarding the temporal nature of selecting a random prize were supported by originally filed disclosure was provided by Applicants, but as a legal matter, '[w]hen interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied.' See In re Spina, 975 F2d 854, 24 USPQ2d 1142, 1144 (Fed Cir 1992); DeGeorge v. Bernier, 768 F2d 1318, 1322, 226 USPQ 758, 761-762 (Fed Cir 1985) (if a claim is ambiguous 'resort must be had to the specification of the patent from which the copied claim came'). Thus, claim interpretation for filed invention is in consideration of MPEP 2111 and above decisions as guidance. Thus, reviewing Place, 5707285C1, the prize wager is a side wager or a wager optionally placed by a player desiring to play for the random prize which prize or side wager is in addition to any wager required for participating normally in the underlying game

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(3:1-3, 13-16, 5:24-51, 7:64-67); the underlying game is the main or primary game that may be blackjack, poker, baccarat which all players participate normally (3:13-18, 5:1-5, 6:21-22) or a electronic game (6:23-26); the predetermined event includes a player receiving a blackjack hand (3:3-5, 17-18, 5:58-66) or a non-winning hand [loser] (6:12-18) and selection of a random prize occurs once [when/if] the predetermined event occurs in the underlying game by activation of a switch or plunger (3:5-6, 5:66-11, 6:53-57).

### *Interference*

3. Applicant has requested that an interference to be declared between claim 11-41 of this application and claim 1, 3-5, 7-33 to Place et al of US Patent No 5707285C1. For an interference to be declared, see 35 USC 135, a claim in the pending application must be patentable. The examiner does not consider a claim to be patentable in this pending application as detailed below. As such, a determination of interference is not proper at this juncture.

### *Specification*

4. The amendment filed Jan 6, 1999 and July 22, 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: if the predetermined event occurs during the underlying [or live card or live] game, then randomly selecting a prize from a predetermined set of prizes [or from a predetermined pay table of distinct prizes] (claim 1c, 11c, 25c, 42c) or activation means for activating said random selection means when the predetermined event occurs (claim 6b, 17b), or if the predetermined event occurs and the player placed a wager on the prize wager, generating [or recording] a random number, selecting a prize from a predetermined

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pay table by comparing the random number to the pay table [of distinct prizes] (claim 23c-d, 38c, 54c, 56c, 69c), recording one random number when the predetermined event occurs, whereby the recorded random number is used in selecting the prize (claim 24b, 39b, 55b, 70b), activation means for activating said random selection means when the predetermined event occurs (claim 32b), an activator for activating said random selector when the predetermined event occurs (claim 48b, 63b), goods or service (claim 16, 31, 47, 62), and electronic game (claim 29) are not supported by originally filed specification and thus enter new matter into the disclosure.

Furthermore, the subject matter of the copied or amended claims in the reissue application must be supported by the disclosure of the original patent under 35 U.S.C. 112, first paragraph. See *In re Molins*, 368 F.2d 258, 261, 151 USPQ 570, 572 (CCPA 1966) and *In re Spencer*, 273 F.2d 181, 124 USPQ 175 (CCPA 1959). In this case, Applicants disclosure 6139430 teaches awarding cash such as a fixed or percentage of a jackpot (8:66-9:3) but not goods or services as claimed, teaches live play (fig 2) but not electronic game and teaches selecting a random prize for every play (fig 3) rather than temporally linked to occurrence of the predetermined event during the underlying game, as claimed. The Office recognizes that selecting a random prize for every round of play as taught by Huard (fig 3) would include those rounds of play where the predetermined event occurs; however, there is no temporal link taught between the predetermined event occurring for the prize selection so that it encourages player participation and builds excitement as taught/disclosed by Place (6:6-10). Applicant did not state that no new matter was entered with amendment.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1-72 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification fails to provide adequate support for an artisan to understand how to make/use the invention as presently claimed regarding the random selection of a prize being temporally linked (in general claim language pertains to either if the predetermined event occurs or when the predetermined event occurs) to occurrence of a predetermined event occurring during the underlying game which includes either a live game or live card game and fails to support an electronic game and fails to support the prize being goods or service, sic. For instance, the instant specification records or generates a random value used for selecting a prize from a table of distinct prizes prior to start of play in the underlying game (7:4-17) rather than when a predetermined event occurs during the underlying game, as claimed. The prize appears to be cash rather than goods or service and the game is a live game or live card game rather than an electronic game.

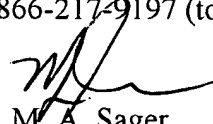
7. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178. MPEP 1416.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
M. A. Sager  
Primary Examiner  
Art Unit 3714

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